

REMARKS

Claims 1, 4-24 remain in this application. Claims 2 and 3 have been canceled. Claims 1, 14, 15 and 21 have been amended.

Claim 1 has been amended to add the limitations of claims 2 making claim 1 subject to a 35 U.S.C.103(a) obvious rejection.

Claim 3 has been canceled and no longer contains matter which formed the basis of the examiners rejection.

Claim 14 has been amended to become independent incorporating the limitations of claim 4 placing it in condition of allowance.

Claim 15 has been amended to correct a typographical error with "and" replacing the word "or"

Claim 21 has been amended to clarify the elements referred to in the amended base claim 14 thereby placing it also in condition of allowance.

Reconsideration of this application is requested.

Claims 1 and 3 were rejected under 35 U.S.C.102(b) as being anticipated in U.S. Patent No. 5,471,405 by Marsh. This rejection is overcome by amendment as claim 2 and 3 have been canceled and the limitations of claim 2 have been added to claim 1. Claim 2 was rejected under 35 U.S.C.103(a) as being unpatentable over Marsh in U.S. Patent No. 5,471,405 in view of Mott in U.S. Patent No. 5,500,635. The 35 U.S.C.103(a) rejection is now directed to claim 1 due to its incorporation of claim 2 and is therefore respectfully traversed.

Claim 1 declares in the preamble that the invention is directed to the life span of

the shock absorbing capability of a shoe sole. On the other hand Marsh limits his structure and function to an area which is to be responsive to the force applied to the sole and then convert this force into information transmitted to a display device worn by a user. His so called "wear monitor" simply subtracts the manufacturers rating from the force measured by the sensor and displays the indication whereas the instant invention is directed to indicating the remaining useful life of the shoe which is an entirely different concept.

Applicant claims at least one sensor capable of producing an electrical current used as a power source. The examiner submitted that Marsh did not claim the exact power source as he uses an analog to digital converter to amplify the signal however Mott teaches a sensor as a power source and resistor network. There can be no prima facie obviousness merely because the prior art can be modified to the claimed form without a suggestion of its desirability. Marsh utilizes an analog to digital converter to accomplish the task which amplifies the signal while changing it from analog to digital. Therefore to add a battery and resistor network would be completely redundant and Marsh would have no reason to make such a suggestion. Applicant submits that it would **not be obvious** for Marsh to look toward Mott to simply add an unnecessary element to his invention.

Claim 1 further claims operational circuitry capable of estimating a remaining life of the shoe. Marsh has no such capability as he displays speed, distance, jump time, hang time, compression of shoe materials etc. and is not concerned with continually estimating the remaining life of the shoe containing the invention.

The instant claim discloses a display apparatus in communication with the operational circuitry which only indicates the estimated remaining life of the shoe. Marsh takes a rather devious path to accomplish multiple readouts as he utilizes an analog to digital converter, a processor, a transmitter, a receiver and a display processor before he actually displays the information.

Claims 2, 4-13, 15-20 and 22-24 were rejected under 35 U.S.C.103(a) as being unpatentable over Marsh in U.S. Patent No. 5,471,405 in view of Mott in U.S. Patent No. 5,500,635.

This rejection is respectfully traversed. As stated previously claim 2 has been incorporated into claim 1 and has been discussed in detail above. Claims 5-13 and 15-20 depend upon the base claim 4 therefore claim 4 must be traversed initially.

Relative to claim 4, applicant adds a resistor network and a microprocessor in the invention. Applicant claims at least one sensor responsive to impacts experienced by the shoe. The examiner submitted that Marsh did not claim the power source. It is noted that Marsh uses an analog to digital converter to amplify the signal however Mott teaches a sensor as a power source and resistor network. There can be no prima facie obviousness merely because the prior art can be modified to the claimed form without a suggestion of its desirability. Marsh utilizes an analog to digital converter to accomplish the task which amplifies the signal while changing it from analog to digital. Therefore to add a battery and resistor network would be completely redundant for Marsh leaving no reason to make such a suggestion. Applicant submits that it would **not be obvious** for Marsh to look toward Mott to simply add an unnecessary element to his invention.

Claim 4 further claims a microprocessor in communication with the resistor network capable of estimating a remaining life of the shoe. Marsh has no such capability as he displays speed, distance, jump time, hang time, compression of shoe materials etc. and is not concerned with continually estimating the remaining life of the shoe containing the invention.

Claim 4 discloses a display apparatus in communication with the microprocessor which only indicates the estimated remaining life of the shoe. Marsh takes a rather devious path to accomplish multiple readouts as he utilizes an analog to digital converter, a processor, a transmitter, a receiver and a display processor before he actually displays the information. While Marsh does have two microprocessors in his system applicant distinguishes in his simplicity.

In relation to claims 5 and 6 these claims are dependent upon the base claim 4 and for the same reasons discussed previously the claims are no longer obvious over Marsh in view of Mott.

Claims 7 and 8 claim at least two sensors and their location. Marsh is silent on this usage but Mott teaches a plurality of sensors. It will be noted that the invention must be taken in combination with the base claim which has been discussed previously.

Relative to claim 9-13 the limitations of these claims must be taken in combination with the base claim which has been discussed previously.

In relation to claims 15-20 for the same reasons discussed previously for claim 1 these claims are no longer obvious over Marsh in view of Mott.

Claims 22-24 are methods used for the producing the invention and therefore it is presented that the same reasons discussed previously are relative to these claims and therefore are no longer obvious over Marsh in view of Mott.

Claims 14 and 21 were objected to as being dependent upon a rejected base claim, but would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As amended claim 14 is now independent having all of the limitations of its base claim 4 and claim 21 depends upon claim 14 therefore both claims are now in condition of allowance.

Accordingly, the rejections under 35 U.S.C. 102 (a) and 103 (b) are deemed overcome by applicant's amendment and remarks.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

A fee of \$43.00 is deemed necessary at this time to add one additional independent claim.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A. O. Cota', with a stylized flourish at the end.

Albert O. Cota

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